

REMARKS

Entry of the foregoing, reexamination and reconsideration of the subject application are respectfully requested in light of the amendments above and the comments which follow.

As correctly noted in the Office Action Summary, claims 1-26 were pending. By the present response, claims 1, 10, 17 and 21-22 have been amended, claims 25-26 have been canceled, and claims 27-29 have been added.. Thus, upon entry of the present response, claims 1-24 and 27-29 are pending and await further consideration on the merits.

Support for the foregoing amendments can be found, for example, in at least the following locations in the original disclosure: page 7, lines 9-10; page 9, line 10; page 15, line 19; page 16, lines 12-15; and the original claims.

CLAIM REJECTIONS UNDER 35 U.S.C. §102

Claims 1-13 and 15-24 stand rejected under 35 U.S.C. §102(b) as being anticipated by WO 02/073142 and U.S. Patent No. 7,206,664 (hereafter "*Schmid*") on the grounds set forth in paragraph 2 of the Official Action. For at least the reasons noted below, this rejection should be withdrawn.

By the present response, claims 1 and 10 have been amended by incorporating the substance of claims 25 and 26 therein, respectively. Since claims 25 and 26 are not rejected on the above-mentioned grounds, the rejection of amended claims 1 and 10 on these grounds would not be appropriate. The remaining claims depend from either claim 1 or 10.

By the present response, claim 21 has been rewritten in independent form.

Claim 21 requires, *inter alia*, a program configured "to select a pipette from an available section." *Schmid* fails to disclose at least this aspect of amended claim 1. Thus, *Schmid* fails to anticipate amended claim 21.

Claims 1-7, 9-21 and 23-26 stand rejected under 35 U.S.C. §102(b) as being anticipated by EP 0 651 306 (hereafter "*Dellacoma et al.*") on the grounds set forth in paragraph 3 of the Official Action. For at least the reasons noted below, this rejection should be withdrawn.

The present invention is directed to an apparatus and method for preparing solutions and/or dilutions. As set forth, for example, on page 24 of the present specification, the apparatus and methods of the present invention advantageously provides a higher level of assurance of accuracy by performing all the computational steps as part of the program and thereby preventing calculation errors. The present invention also advantageously indicates whether or not the end product is plausible based upon the weight of the completed solution, thereby adding a "quality check." Finally, the present invention is capable of creating a clear record which assures the traceability of the formulation of the solution.

An apparatus constructed according to the principles of the present invention is set forth in amended claim 1. Amended claim 1 recites:

1. *Apparatus for preparing a solution of a solid with a liquid and/or a dilution of a liquid with another liquid, comprising: a balance comprising a weighing pan, a display- and operating unit, a processor, a storage memory, and a data interface; and at least one electronic pipette, the pipette being equipped with a microprocessor, a memory unit, and a data interface, wherein a communication can be established between the data interface of the balance and the data interface of the at least one electronic pipette, wherein the electronic pipette has an*

identifier element that signals when the electronic pipette has been selected, and wherein the balance comprises a program executable for preparing a solution of a solid with a liquid and/or a dilution of a liquid in another liquid, said program being configured for performing calculations in the processor of the balance based on instructions input by an attendant, also based on substance data stored in the memory of the balance and in certain cases based on weighing results, said program being further configured for selecting a dosage delivery device from an available selection and setting the dosage delivery device for the liquid volume that is to be taken in and/or dispensed.

A method performed according to the principles of the present invention is set forth in amended claim 10. Amended claim 10 recites:

10. Method for preparing a solution of a solid with a liquid and/or a dilution of a liquid with another liquid, wherein the method includes:

connecting a balance comprising a display- and operating unit, a processor, a storage memory, and a data interface with at least one electronic pipette, the pipette being equipped with a microprocessor, a memory unit, a data interface, and an identifier element, wherein the balance and the at least one electronic pipette can communicate with each other through their respective data interfaces, and wherein the processor of the balance comprises a program that performs calculations based on instructions given by the attendant, also based on substance data stored in the memory of the balance and in certain cases based on weighing results;

wherein said program selects a pipette from an available selection, sets the pipette for the liquid volume that is to be taken in and/or dispensed; and

activates the identifier element of a selected electronic pipette.

Dellacoma et al. fails to anticipate either the apparatus or method of claims 1 or 10.

As evident from the above, claim 1 requires, *inter alia*, "at least one electronic pipette." Similarly, claim 10 requires, *inter alia*, "connecting a balance . . . with at least one electronic pipette."

In paragraph 3 of the Official Action, it is asserted that the metering means (5) of *Dellacoma et al.* constitutes a pipette element. This assertion is respectfully traversed. The word "pipette" is a term of art. A pipette is defined as:

pipette: a small piece of apparatus which typically consists of a narrow tube into which fluid is drawn by suction (as for dispensing or measurement) and retained by closing the upper end —**pipette** also **pipet** verb **pi-pet-ted**; **pi-pet-ting**.
Dictionary.com. Merriam-Webster's Medical Dictionary, Merriam-Webster, Inc.
<http://dictionary.reference.com/browse/pipette>
(accessed: June 27, 2008).

Thus, as evident from the above, a pipette is constructed to draw in fluid by suction, fluid being retained by closing the upper end of the pipette. The metering means 5 of *Dellacoma et al.* fails to disclose such a device. According to the teachings of *Dellacoma et al.*, solvent is pumped into the chamber 55 of the metering means 5 via an inlet 56 by a drawing means 7, such as a pump. A vertically movable pin 54 is then actuated in an upward movement to create a passage for a solvent to escape from the chamber 55 and be deposited within the container 3. However, it is readily apparent that the metering means 5 is not constructed in a manner which would permit it to draw fluid into the device by suction, nor is it constructed such that the liquid could then be held within the device by closing a top end thereof. Thus, for at least the reasons explained above, the metering means 5 of *Dellacoma et al.* does not constitute a pipette. Therefore, *Dellacoma et al.* fails to disclose each and every element required by claims 1 and 10. Reconsideration and withdrawal of the rejection is respectfully requested.

It is noted that by the present response claim 21 has been rewritten in independent form. Claim 21 requires, *inter alia*, "the program is configured to select a pipette from an available selection." *Dellacoma et al.* clearly fails to disclose a

pipette of any sort whatsoever, at least for the reasons explained above, and additionally fails to include a program which is configured to select a pipette from an available selection thereof. Thus, for at least these reasons, amended claim 21 is also not anticipated by *Dellacoma et al.*.

Claims 1-7 and 9-24 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 7,110,861 (hereafter "*Nelson et al.*") on the grounds set forth in paragraph 4 of the Official Action. For at least the reasons noted below, this rejection should be withdrawn.

By the present response, claims 1 and 10 have been amended so as to incorporate the substance of claims 25 and 26 therein. Thus, since neither claims 25 nor 26 were rejected on the basis of *Nelson et al.*, amended claims 1 and 10 are likewise distinguishable therefrom.

It is noted that by the present response, claim 21 has been rewritten in independent form. Claim 21 requires, *inter alia*, "the program is configured to select a pipette from an available selection." It is respectfully submitted that *Nelson et al.* fails to disclose at least this aspect of amended claim 21. Thus, amended claim 21 is not anticipated by *Nelson et al.*

CONCLUSION

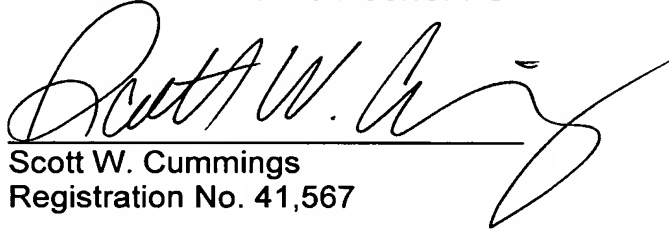
From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: July 11, 2008

By:



Scott W. Cummings
Registration No. 41,567

P.O. Box 1404
Alexandria, VA 22313-1404
703 836 6620